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In re Application of
ICHIMURA, et al.
U.S. Application No.: 09/856,617
PCT No.: PCT/JP99/06487
Int. Filing Date: 19 November 1999
Priority Date: 24 November 1998
Attorney Docket No.: 766.52
For: NOVEL POLYPEPTIDE

DECISION ON PETITION

UNDER 37 CFR 1.137(a)

This decision is in response to applicant's "Petition to Revive Unavoidably Abandoned Application Under 37 CFR § 1.137(a)" filed 13 August 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 17 May 2004, applicant was mailed a decision dismissing applicant's renewed petition under 37 CFR 1.181 to withdraw the holding of abandonment in the present application.

On 13 August 2004, applicant filed a petition under 37 CFR 1.137(a).

DISCUSSION

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be filed promptly after applicant becomes aware of the abandonment, and such petition must be accompanied by: (1) A proper response, unless already filed; (2) The petition fee as set forth in §1.17(i); (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) A terminal disclaimer (if necessary). Applicant has satisfied item (1) and (2) above; item (4) is not applicable.

As to item (1), a review of USPTO records finds that the sequence listing and CRF filed 05 February 2004 has been found compliant and entered.

Concerning item (2), the check for \$110.00 referenced in applicant's petition was not received by the USPTO. However, as previously authorized, this fee will be deducted from Deposit Account No.: 06-1205.

Regarding item (3), the circumstances identified by applicant do not satisfy the exacting standard applied when determining whether the cause of abandonment was unavoidable. In order for a petition under 37 CFR 1.137(a) to be granted, applicant at a minimum must provide: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See, Manual of Patent Examining Procedure (MPEP) § 711.03(c)(III)(C) and specifically MPEP § 711.03(c)(III)(C)(2). As stated in the MPEP:

[a] petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of the delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).

In the present case, applicant has not provided any evidence to show that the abandonment of the present National stage application was unavoidable, as opposed to unintentional, within the context of the regulation. The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) has provided the Office of PCT Legal Administration with further clarification as to the filed CRF disks and whether applicant was properly informed of the errors contained therein. Each error report, in addition to the hand annotations, contains a verification summary at the back. The 'verification summary' is a printout of all errors found in a CRF by the validation program. Therefore, applicant was notified of all of the errors in the verification summary. In addition, applicant was advised to run the filed CRF through the "Checker" software prior to filing to identify any potential problems.

Because applicant has failed to satisfy all the requirements for a grantable petition under 37 CFR 1.137(a), this application remains abandoned with respect to the United States.

CONCLUSION

The petition to revive under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)."

As an alternative, applicant is advised to consider filing a petition to revive under 37 CFR 1.137(b) for unintentional, rather than unavoidable, delay.

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law (\$650.00), (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." and (4) any

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terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required). A copy of the appropriate petition form is enclosed for applicant's convenience.

The application remains **ABANDONED** as to the United States of America.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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